

REMARKS

The Applicant respectfully requests reconsideration and Allowance of Claims 1-20 in view of the following arguments.

35 U.S.C. §103 REJECTIONS

Claims 1-3, 6, 7 and 14-15 were rejected under 35 U.S.C. §103(a) as obvious over Kato et al. (US Patent 6,631,495) in view of Withgott et al. (U.S. Patent 5,748,805). [The Applicant notes that although the claim listing does not list Independent claim 11, the Examiner's remarks (Page 3) specifically states that "Claims 11 and 14 are similarly analyzed as claim 1". Thus Applicant files this response accordingly.].

Claims 4, 8-10, 12, 13 and 16-20 were rejected under 35 U.S.C. §103(a) as obvious over Kato et al. (US Patent 6,631,495) , Withgott et al. (U.S. Patent 5,748,805) in further view of Antognini et al. (U.S. Patent 6,176,427).

STATUS OF THE CLAIMS

Claims 1-20 remain pending in this case.

INDEPENDENT CLAIMS 1, 11 AND 14 ARE NOT SUGGESTED BY THE CITED ART

The Examiner rejected independent Claims 1, 11 and 14 under 35 U.S.C. §103(a) as suggested by the combination of U.S. Patent 6,631,495 to Kato et al. (Kato) in view of Withgott et al. U.S. Patent 5,748,805 (Withgott). Applicant respectfully traverses this rejection on the ground that Kato and Withgott, whether alone or in combination, do not suggest Applicant's invention as claimed and, further, there is no suggestion in any of the references to modify the Kato device so as to render obvious Applicant's invention.

THE KATO PATENT

The Kato patent discloses an electronic document filing method and system consisting of adding identification code to the electronic document. (Abstract). In particular, Kato discloses a method and system for adding an identification code to a particular document without narrowing the document print area or interfering with the document

layout, for the ultimate purpose of retrieving the corresponding electronic document based on the identification code. (See, e.g., Column 2, lines 61-67; Column 3, lines 9-10; Column 10, lines 18-23).

Nothing in Kato teaches machine readable code, directed to additional information, added to said printed material as required in pertinent part by each of the independent claims 1, 11 and 14. As set forth at page 7, lines 28-31, for example, Applicant specifically defined the term “additional information”: “For the purposes of this invention, it is to be understood that what is meant by “additional information” is information on a separate, local or remote, database considered relevant to the printed material 14 on which the machine readable code 12 is added.” (See also, page 4, lines 24-31; page 5, lines 18-34 and page 6, lines 1-3; and page 7, lines 28-34 and page 8, lines 1-3, for example).

Simply put, Kato is directed to identifying a particular document and adding a code to retrieve that particular document. Applicant’s invention is not concerned with retrieving the document upon which the code is printed but uses the code to locate other relevant additional information.

THE WITHGOTT PATENT

The Withgott patent discloses a device for identifying supplemental material hopefully relevant to a document without decoding the document image. (Abstract) The problem Withgott attempts to solve is the problem of dealing directly with bit mapped document images rather than with character code representations (such as ASCII for text images). According to Withgott, in contrast to ASCII text files, which permit users to perform operations such as Boolean algebraic key word searches to locate text of interest, text information that is scanned without decoding is difficult to retrieve without exhaustive viewing of each document. (Column 2, lines 1-14)

What Withgott does, as set forth at the column and lines identified by the Examiner, is segment an existing scanned image itself into “significant image units” and retrieves information possibly relevant to the significant image units. (Column 3, lines 30-43 and lines 58-67). The morphological image characteristics used to identify “significant image units” include image unit shape dimensions, typeface, font, location in the document image and frequency of image unit occurrence. (Column 3, lines 44-47).

In short, Withgott discloses a system for analyzing a scanned image and identifying parts of the image as “significant image units” and uses these significant image units to

locate other hopefully relevant material. Nothing in Withgott discloses or suggests adding machine readable code specifically directed to selected additional relevant material as required by the Applicant's three independent claims 1, 11 and 14.

THE ANTOGNINI PATENT

The Antognini patent discloses a method of formatting data and a method of decoding the formatted digital data. (Abstract). Nothing in Antognini teaches Applicant's invention, as the Examiner admits, or suggests it as it is claimed as discussed above. Further, as set forth above, nothing in Kato or Withgott teaches or suggests Applicant's invention. Thus, Applicant respectfully submits that it is impossible for the combination to teach or suggest Applicant's invention as claimed.

The Applicant therefore respectfully submits that independent Claim 1, as well as independent Claims 11 and 14 which require limitations similar to those in Claim 1, are not anticipated by, nor obvious over, Kato either alone or in combination with Withgott and Antognini and are entitled to allowance along with dependent claims 2-10 from Claim 1, dependent claims 12-13 from Claim 11 and dependent claims 15-20 from Claim 14.

Further, it is fair to point out that in order to combine prior art references or modify a prior art reference under 37 U.S.C. 103, there must be some teaching or suggestion in the prior art to make the combination or modification. In this case, the Examiner does not point to any teaching or suggestion in the prior art to modify the admittedly deficient Kato reference other than to state that it would have been obvious to one of ordinary skill in the art at the time of the invention to have done so. Applicant respectfully disagrees.

Kato is an already functioning electronic document filing method and system consisting of adding identification code to the electronic document for the purpose of retrieving that particular document. Among other things, as discussed and claimed above, Applicant's invention teaches adding machine readable code, directed to additional information, to printed material for the purpose of retrieving additional relevant

material. Neither Withgott nor Antognini disclose this required element of Applicant's invention as discussed above. Nonetheless, if the proposed modification of the prior art would change the principle of operation of the prior art device, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F. 2nd 810, 123 U.S.P.Q. 349 (CCPA 1959) (see MPEP § 2143.01 at page 2100-99, second column). It is clear that adding Withgott, or Antognini would change the principle by which Kato operates. Thus, in accordance with *In re Ratti*, it could not have been obvious to make the Examiner's proposed modifications.

The Applicant therefore respectfully submits that independent Claim 1, as well as independent Claims 11 and 14 which require limitations similar to those in Claim 1, are not anticipated by, nor obvious over, Kato either alone or in combination with Withgott and/or Antognini and are entitled to allowance along with dependent claims 2-10 from Claim 1, dependent claims 12-13 from Claim 11 and dependent claims 15-20 from Claim 14.

CITED BUT NON-APPLIED REFERENCES

The subsidiary references have been reviewed but are submitted to be less relevant than the relied upon references.

CONCLUSION

In light of the above, Applicant respectfully requests reconsideration and allowance of Claims 1-20. If the Examiner should feel that any issue remains as to the allowability of these claims, or that a conference might expedite allowance of the claims, the Examiner is asked to telephone the undersigned attorney.

Applicant intends this to be a complete response. No fee is believed due; however if a fee is due, please charge the deposit account number indicated on the transmittal letter.

Respectfully submitted,

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